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09/954,775	09/18/2001	Michael Orlando Cimini	13DV-13971 (12729-180)	7795
29399 7590 03/12/2009 JOHN S. BEULICK (12729) C/O ARMSTRONG TEASDALE LLP ONE METROPOLITAN SQUARE SUITE 2600 ST. LOUIS, MO 63102-2740				
EXAMINER SAINDON, WILLIAM V				
ART UNIT 3623		PAPER NUMBER		
NOTIFICATION DATE 03/12/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatents@armstrongteasdale.com

Office Action Summary

Application No.

09/954,775

Applicant(s)

CIMINI ET AL.

Examiner

WILLIAM V. SANDON

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following NON FINAL Office Action is in response to Applicant's submission received December 8, 2008. Claims 1, 9, and 15 were amended. No claims were added or canceled. Therefore, claims 1 and 3-20 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 8, 2008 has been entered.

Response to Amendment

3. The 35 USC § 112 ¶ 2 rejection of claims 1 and 3-20 is not withdrawn in light of Applicant's amendments. The amendments do not clarify the scope of the "compare" element. Please refer to the rejection below.
4. The 35 USC § 103 rejection of claims 1 and 3-20 has been updated to accommodate the newly claimed subject matter.

Response to Arguments

5. Applicant argues that the claims are distinguishable over Powers and Suzuki because the weights are assigned by a "user" in the claims, and not by the references. However, the examiner respectfully disagrees with applicant.

First, the examiner would like to point out that Powers clearly discloses a human being providing the weights. At col. 9, line 19-35, the weights are assigned "depending on their importance to the enterprise." At no point does it say the weights are assigned by an enterprise. It is unreasonable to interpret a non-human as assigning the weights. Even if the enterprise were to assign the weights, enterprises are merely an aggregation of humans. Software may be able to generate weights, but only with specific instruction as to how to generate the weights by a human programmer. However, Powers does not disclose such a software system, and it is unreasonable to consider Powers' weights as derived by software without any mention of such software. Therefore it is clear that Powers discloses weights assigned by the only reasonable entity capable of performing such an act: a human being.

Further, at col. 8, line 51 to col. 9, line 6, it is clear that "managers," which are human, are performing the evaluations depicted in Fig. 5, which includes the weighting of the questions.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 9-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** The steps recited do not qualify as a statutory process. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another machine (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The claims are not tied to another machine. The steps recited either do not require a particular machine (e.g. a particular computer), or only mention a nominal recitation of a computer (e.g. "using a computer"). Therefore, the claims are non-statutory.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. **Claims 1 and 3-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claims contain subject matter that was not described in the specification in such a way as to enable one skilled

in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The independent claims recite a "compare" function, which has (see § 112 ¶ 2 rejection below) some unknown result. However, the claims and specification provide no guidance as to how this function operates. A mere statement of the goal of a function fails to disclose how to make and/or use the function.

The claim describes the desired result of a function: "compar[ing]." The claim itself does not define the structure or method of the function used to reach that result. The claimed limitation does not fall under 35 USC § 112 ¶ 6 - "means for," which would allow the scope of the claim to be defined as the particular methods or structure enumerated in the specification. Further, one of ordinary skill in the art would not understand the "compar[ing]" limitation to imply any particular structure or method. Therefore, the claim is properly construed to encompass any and all means for comparing.

Further, claim 6 (and similar claims from other independents) recites: "evaluate weighted summed data," but provides no method for achieving this stated goal.

When a limitation encompasses any and all structures or acts for performing the recited function, including those which were not what the applicant had invented, the disclosure fails to provide a scope of enablement commensurate with the scope of the claim. See Ex parte Miyazaki, Appeal No. 2007-3300, p. 27 (BPAI, 2008) (referencing Halliburton Oil Well Cementing Co. v. Walker, 329 US 1 (1946)). Because the disclosure does not enable every structure and act that reasonably falls within the

claim's scope, the disclosure fails to provide an adequate scope of enablement as required by 35 USC 112, first paragraph.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. **Claims 1 and 3-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In the independent claims, using claim1 as an example, the "compare" limitation "compare[s] the received information in the form of answers to respective questions presented to the user, to the reference process that represents the ideal production process, wherein each question is related to at least one category of the production process." The comparison is between the "received information" and "the reference process." The "received information is "in the form of answers." However, the received information is defined in a previous limitation as "process production capability information data ... [that] includes a reference process that represents an ideal production process." It is unclear how the information can be compared to itself, and how it relates to answers that were never previously presented. Where do the answers and questions come from? It appears that one or more steps are missing.

Further, the "display at least one suggestion" element is unclear. A suggestion is "displayed for each category of the production process ... based on a user selection of the category for which to display the ... suggestion. How can something display each

category by displaying only one selected category? The claim starts with multiple suggestions displayed for each category and then all of a sudden only one category is displayed (for a selected category). Therefore, the claim is indefinite.

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. **Claims 1 and 3-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powers et al. (U.S. 6,604,084) in view of Suzuki et al. (U.S. 6,625,511).**

As per claim 1, Powers et al. discloses a system for evaluating process performance, said system comprising:

a device (See figure 1 and column 2, line 58-column 3, line 13, wherein a client device is disclosed); and

a server connected to said device and configured to receive, from a user via said device, information pertaining to process performance evaluation categories selected by the user (See column 9, lines 47-64, column 11, lines 32-60, wherein the evaluation categories are set up by a user), said server further configured to:

receive process production capability information data using a computer, wherein the process production capability information includes a reference process that represents an idea production process (See figure 1, column 2, lines 58-67, and column

3, lines 14-24; Fig. 5A, noting for example question 10 represents an ideal process wherein an agent does not miss work);

receive a per category weighted value assigned by a user (See column 9, lines 19-35, noting that the question is assigned a weight by the user based upon the category of the question. In the example given the question relates to the category "promptness," and based upon the importance of promptness to the company, a weight is given; column 11, line 62-column 12, line 25);

compile the received information (See column 2, lines 1-12, column 3, lines 39-55, column 4, lines 20-40, column 9, lines 14-32, which compile received information);

display to the user information related to the production process (See column 2, lines 1-12, column 3, lines 39-55, column 4, lines 20-40, and column 5, lines 25-28, wherein information is displayed to a user);

compare the received information in the form of answers to respective questions presented to the user, to the reference process that represents the ideal production process, wherein each question is related to at least one category of the production process (See column 4, lines 25-40, column 5, lines 10-28, column 9, lines 7-18 and 28-47, column 11, line 49-column 12, line 10 and lines 44-51, which discloses processing the received information against reference information. The received information is in the form of answers to questions stored in the system. These answers are compared against all possible answers to the questions, and are in reference to a performance ideal. See column 1, lines 34-46 and 58-65, column 3, lines 43-column 4, line 25,

column 8, line 61-column 9, line 20 and lines 48-64, and column 13, lines 32-45, which discloses the relationship of questions to performance areas and categories); and

display the results of the compared information based on the weighted value assigned by the user to the user via said device wherein the results include a numerical score representing a relative capability of the process being evaluated to perform a desired function (See column 2, lines 1-12 and 50-60, column 3, lines 39-55, column 4, lines 20-40, and column 5, lines 25-28, wherein results information is displayed to a user. These results concern the evaluation of productivity and quality of a process); and

display information useful in determining the overall performance and identifying ways to improve performance (See column 4, lines 25-35),

wherein the results and information are sortable based on filters associated with categories of the process (See column 4, lines 25-35, column 5, lines 10-30, column 6, line 66-column 7, line 11, and column 13, lines 25-50 and 63-67);

wherein the at least one suggestion is based on the received information in the form of answers to respective questions (See column 4, lines 25-40, column 5, lines 10-28, column 9, lines 7-18 and 28-47, column 11, line 49-column 12, line 10 and lines 44-51, which discloses processing the received information against reference information. The received information is in the form of answers to questions stored in the system);

and wherein the at least one category results and information is displayed for each category of the production process based on user selection of that category for which to display the at least one category results and information (See column 3, lines 43-column 4, line 25, column 8, line 61-67, column 11, lines 49-60, and column 13, lines

32-45, disclosing the relationship of questions to performance areas and categories, wherein the completed evaluations are output and displayed to the user, and each category is specified in a separate table). Further, in the broadest reasonable interpretation, only one category is required and thus one category is displayed one at a time.

However, Powers et al. does not expressly disclose that the desired function is a manufacturing function or displaying at least one suggestion for improving performance, wherein the suggestions are sortable.

Suzuki et al. discloses manufacturing functions and displaying at least one suggestion for improving performance, wherein the suggestions are sortable (See figure 11, column 7, lines 60-67, column 12, lines 30-40 and 60-67, column 19, lines 15-35, column 20, lines 55-63, which discloses evaluating a manufacturing process and/or function and displaying point by point suggestions for improvement. See specifically column 20, lines 54-67, which discloses sorting the results and displaying improvements in descending order).

Powers et al. discloses a performance evaluation system that uses questions and production associated with performance areas to generate quality and performance reports concerning an individual, group, process, or other suitable type of item or operation. Powers et al. specifically discloses that the results and information displayed are sortable based on filters associated with categories of the process. Manufacturing functions are a type of process or operation. Suzuki et al. discloses evaluating manufacturing processes and/or functions and displaying suggestions for improvement

via a computer display, wherein improvements are displayed sorted in descending order. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the performance evaluation system of Powers et al. in the manufacturing field in order to more efficiently generate evaluation data and reports in the manufacturing industry through application of an automated system. Powers et al. discusses the ability of the system to allow an enterprise to set up the performance evaluation system to fit the organizational structure of that specific enterprise, thus making the tool customizable to any enterprise and enterprise situation. See column 2, lines 58-64, column 5, lines 10-20 and line 65-column 6, line 5. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to display suggestions to the user based on the performance evaluation performed by Powers et al. in order to more efficiently improve the quality of the manufactured items by reducing the likelihood of errors associated with manufacturing. See Suzuki et al., column 3, lines 20-25, 37-45, and 60-67.

As per claim 3, Powers et al. discloses wherein said server is further configured to receive information regarding at least one of a planning, shop practices, and operator skill (See column 9, lines 5-30, which discloses receiving information regarding operator skill).

As per claim 4, Powers et al. discloses wherein said server is further configured to receive information regarding at least one of a complexity, conditions, control, error proofing, measurement, and process (See column 2, lines 50-60, column 3, lines 45-60, which discloses productivity analysis of the process).

As per claim 5, Powers et al. discloses wherein said server further configured to receive information including a numerical score that expresses a relative capability of a process performance (See column 1, line 57-column 2, line 12 and lines 51-57, column 3, lines 45-60, column 4, lines 26-36, column 9, lines 48-55, and column 13, lines 20-35, wherein information is received that expresses a relative capability of a process performance). However, Powers does not expressly disclose that this process performance is performing a desired manufacturing function.

Powers et al. discloses a performance evaluation system that utilizes productivity and quality data. Powers et al. specifically discloses that the performance evaluation system is used to evaluate an individual, a group, a process, or other suitable types of operation. See column 2, lines 50-60, and column 5, lines 45-52. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to receive information regarding the process of a manufacturing function in order to more efficiently perform a performance evaluation this process by efficiently communicating with users of a network environment that have input regarding the process. See column 1, lines 35-47, and column 2, lines 1-12, which discuss the benefits of such an automated system.

As per claim 6, Powers et al. discloses wherein said server is further configured to:

sum received information weights assigned by the user for each category (See column 9, lines 10-30, column 10, lines 1-12, and column 11, line 62-column 12, line 25, wherein received information is summed);

evaluate weighted summed data based on category selected (See column 9, lines 10-30, column 10, lines 1-12, and column 11, line 62-column 12, line 25, wherein the data is evaluated); and

As per claim 7, Powers et al. teaches wherein said device is configured to be a server for a network of customer devices (See figure 1 and column 2, line 58-column 3, line 22, column 5, lines 25-45, wherein the device serves to other devices).

As per claim 8, Powers et al. discloses wherein said server and said device are connected via a network (See figure 1, column 3, lines 1-20, column 5, lines 39-45, wherein the server and device are connected via a network).

As per claim 9, Powers et al. teaches a method for evaluating performance capabilities of a production process by operating a system including a server and at least one device connected to the server, said method comprising:

defining, using a computer, area categories based on an evaluation of the production performance capabilities of at least one of the process and the part being evaluated (See figure 5A-B, column 1, line 58-column 2, line 5 and lines 50-60, column 3, lines 45-60, column 8, line 60-column 9, line 30 and lines 45-60, wherein evaluation areas are established to evaluate performance capabilities of the process); and

receiving, using the computer, information relevant to the capabilities of the production process within the evaluation categories, wherein the information relevant to the capabilities of the process production includes a reference process that represents an ideal production process (See column 2, lines 1-12 and 50-60, column 5, lines 25-30, column 9, wherein information is received; Fig. 5A, noting process ideals).

Powers et al. and Suzuki et al. further teaches the remaining elements, which are equivalent to limitations in claim 1. Therefore, these elements are rejected using the same art and rationale set forth above in the rejection of claim 1.

As per claim 10, Powers et al. discloses assigning a weight factor to information received within each evaluation category (See column 9, lines 10-30, column 10, lines 1-12, and column 11, line 62-column 12, line 25, which disclose weight factors).

Claim 11 recites substantially similar elements to claim 5 and is therefore rejected using the same art and rationale as set forth above.

As per claim 12, Powers et al. discloses wherein displaying the results further comprises numerically ranking the production process evaluation areas based on the results (See column 2, lines 1-12, column 3, lines 39-55, column 4, lines 20-40, and column 5, lines 25-28, wherein results are displayed in a numerically ordered ranking).

As per claim 13, Powers et al. teaches wherein displaying the results further comprises displaying the results in a format that facilitates comparisons between a plurality of production process evaluation areas (See column 3, line 43-column 4, line 15 and lines 25-35, column 5, lines 25-30, wherein the results are shown by date, time, user, hierarchical level, etc.).

As per claim 14, Powers et al. teaches wherein defining evaluation area categories further comprises selecting at least one evaluation area category that represents at least one of production complexity, conditions, control, error proofing, measurement, operator skill, planning, process, and shop practices (See figures 5A-B,

column 2, lines 50-60, column 3, lines 45-60, column 9, lines 5-30, which disclose at least operator skill and productivity analysis).

As per claim 15, Powers et al. teaches a method for evaluating performance of a production process using a network connecting a plurality of users, the network including a server and a plurality of user display devices, said method comprising:

receiving from the users using a computer, information concerning evaluation categories relevant to the production process, wherein the evaluation categories are selected by the users, and wherein the information concerning evaluation categories relevant to the production process includes a reference process that represents an ideal production process (See column 2, lines 1-12 and 50-60, column 5, lines 10-27, column 9, lines 20-45, which disclose soliciting information from users; Fig. 5A);

assigning each evaluation category at least one weighted factor that normalizes the received information with respect to the received information's relative contribution to a process capability improvement (See column 9, lines 10-30, column 10, lines 1-12, and column 11, line 62-column 12, line 25, which disclose weight factors that regulate each questions worth in the overall score);

Powers et al. and Suzuki et al. further teach the remaining elements, which are equivalent to limitations in claim 1. Therefore, these elements are rejected using the same art and rationale set forth above in the rejection of claim 1.

Claims 16, 17, 19, and 20 recite substantially similar elements as claims 13, 14, 5, and 12, respectively, and are therefore rejected using the same art and rationale as set forth above.

As per claim 18, Powers et al. discloses wherein soliciting from the users information concerning evaluation categories further comprises soliciting information from the users via at least one of a survey, radio push-buttons, and pull-down menu (See column 9, lines 20-45, which disclose at least radio buttons and drop-down lists).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM V. SAINDON whose telephone number is (571)270-3026. The examiner can normally be reached on M-F 7:30-5; alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/wvs/

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